

## REMARKS

Claims 1-4, 6-12, 14-15, 17-18 and 20-23 are pending. Claims 1 and 15 are amended herein. No new matter is added as a result of the claim amendments.

### 102 Rejections

The instant Office Action states that Claims 1-4, 6, 8-12, 14-15, 17-18, 20-21 and 23 are rejected under 35 U.S.C. § 102(e) as being anticipated by O'Brien (U.S. Patent No. 6,886,110). The Applicants have reviewed the cited reference and respectfully submit that the present invention as recited in Claims 1-4, 6, 8-12, 14-15, 17-18, 20-21 and 23 is not anticipated nor rendered obvious by O'Brien.

According to independent Claim 1, an embodiment of the present invention is directed to a system that includes “a signal selector ... for selecting between an output signal that is output from said first device and a bypass signal that has bypassed said first device, said selecting depending on whether said signal selector detects power in a first power rail coupled to said first device” (emphasis added). Claims 2-4, 6 and 8 are dependent on Claim 1 and recite additional limitations.

According to independent Claim 9, an embodiment of the present invention is directed to a method that includes “selecting a bypass signal ...; selecting an output signal instead of said bypass signal, ... wherein said output signal is selected when power is detected in a first power rail coupled to said first device and wherein otherwise said bypass signal is selected” (emphasis added). Claims 10-12 and 14 are dependent on Claim 9 and recite additional limitations.

According to independent Claim 15, an embodiment of the present invention is directed to a system that includes "a first device ... coupled to a first power rail; ... and a signal selector ... also coupled to said first power rail, wherein said signal selector selects between an output signal ... and an input signal ... depending on whether said signal selector detects power in said first power rail" (emphasis added). Claims 17-18, 20-21 and 23 are dependent on Claim 15 and recite additional limitations.

Thus, each and every claim recites that a signal selector selects between one of at least two signals by sensing whether or not power is detected on a power rail. Applicants respectfully submit that this claimed feature is not shown or suggested by O'Brien.

The instant Office Action only states that a first power rail coupled to the first device is inherent in O'Brien. Regardless of whether or not such a power rail is inherent in O'Brien, each of the claims recites additional limitations not addressed in the instant Office Action and not shown or suggested by O'Brien. In other words, even if such a power rail is inherent in O'Brien, Applicants respectfully submit that O'Brien neither shows nor suggests a signal selector that selects between one of at least two signals by sensing whether or not power is detected on the power rail, nor is such a claimed feature inherent in O'Brien. Not only can Applicants find no showing or suggestion of this claimed feature in O'Brien, the instant Office Action fails to address this claimed feature.

O'Brien appears to mention a selection module, and indeed the instant Office Actions cites a portion of O'Brien that mentions the selection module. However, the selection module of O'Brien is for selecting a device within a scan chain, but it is not for selecting one signal over another, and in particular it is

not for selecting between one of at least two signals by sensing whether or not power is detected on a power rail, as claimed. Therefore, Applicants respectfully submit that O'Brien does not teach that which it is relied upon as teaching.

Accordingly, Applicants respectfully submit that O'Brien does not show or suggest the embodiments of the present claimed invention recited in independent Claims 1, 9 and 15 and that these claims are considered patentable over O'Brien. Because Claims 2-4, 6, 8, 10-12, 14, 17-18, 20-21 and 23 depend from Claim 1, 9 or 15 and recite additional limitations, Applicants respectfully submit Claims 2-4, 6, 8, 10-12, 14, 17-18, 20-21 and 23 are also considered patentable over O'Brien. As such, Applicants respectfully submit that the basis for rejecting Claims 1-4, 6, 8-12, 14-15, 17-18, 20-21 and 23 under 35 U.S.C. § 102(e) is traversed.

Furthermore, with regard to Claims 4, 12 and 18, the instant Office Action alleges that a signal selector coupled to a standby power rail (Claim 4) or coupled to both a first power rail and a standby power rail (Claims 12 and 18) is inherent in O'Brien. Applicants respectfully disagree. The Examiner is respectfully directed to Section 2112 of the Manual of Patent Examining Procedure (MPEP). The fact that a certain characteristic may be present in the cited reference is not sufficient to establish the inherency of that characteristic. In relying upon inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the alleged inherency of the limitations of Claims 4, 12 and 18; such a basis is not provided in the instant Office Action.

As O'Brien fails to even mention a first power rail, much less a second (standby) power rail, Applicants respectfully submit that there is no basis for

concluding that the limitations of Claims 4, 12 and 18 are inherent, and respectfully request that either a basis for reaching the conclusion of inherency, or a reference showing the limitations of those claims, be provided.

Moreover, with regard to Claims 6 and 21, the instant Office Action alleges that a second device coupled to a second power rail (Claim 6), or a first device coupled to one power rail with a second device coupled to a different power rail (Claim 21), is inherent in O'Brien. Applicants respectfully disagree. As mentioned above, the fact that a certain characteristic may be present in the cited reference is not sufficient to establish the inherency of that characteristic. In relying upon inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the alleged inherency of the limitations of Claims 6 and 21; such a basis is not provided in the instant Office Action.

As O'Brien fails to even mention a first power rail, much less a second power rail, Applicants respectfully submit that there is no basis for concluding that the limitations of Claims 6 and 21 are inherent, and respectfully request that either a basis for reaching the conclusion of inherency, or a reference showing the limitations of those claims, be provided.

#### 103 Rejections

The instant Office Action states that Claims 7 and 22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over O'Brien in view of Jarwala (EP 0662616). The Applicants have reviewed the cited references and respectfully submit that the present invention as recited in Claims 7 and 22 is not anticipated nor rendered obvious by O'Brien and Jarwala, alone or in combination.

Claim 7 is dependent on independent Claim 1 and recites additional limitations, and Claim 22 is dependent on independent Claim 15 and recites additional limitations. Thus, by demonstrating that Claims 1 and 15 are not shown or suggested by O'Brien and Jarwala, it is also demonstrated that Claims 7 and 22 are not shown or suggested by O'Brien and Jarwala.

As presented above, Applicants respectfully assert that O'Brien does not show or suggest the limitations of Claims 1 and 15. Applicants further submit that Jarwala does not overcome the shortcomings of O'Brien. More specifically, Applicants respectfully submit that Jarwala, alone or in combination with O'Brien, does not show or suggest the limitations of Claims 1 and 15 cited hereinabove. Jarwala explicitly utilizes an externally generated control signal (BCE) supplied from an external source such as a test controller (please refer to column 6, lines 4-25, and in particular lines 17-22, of Jarwala). Indeed, the present claimed invention eliminates such additional control logic (please refer to page 6, lines 4-8, of the instant application).

Therefore, Applicants respectfully submit that O'Brien and Jarwala, alone or in combination, do not show or suggest the embodiments of the present claimed invention recited in independent Claims 1 and 15 and that these claims are considered patentable over O'Brien and Jarwala. Because Claims 7 and 22 depend from either Claim 1 or 15 and recite additional limitations, Applicants respectfully submit Claims 7 and 22 are also considered patentable over O'Brien and Jarwala. As such, Applicants respectfully submit that the basis for rejecting Claims 7 and 22 under 35 U.S.C. § 103(a) is traversed.

Conclusions

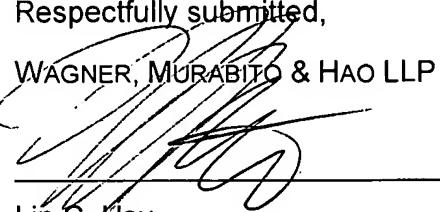
In light of the above remarks, Applicants respectfully request reconsideration of the rejected claims.

Based on the arguments presented above, Applicants respectfully assert that Claims 1-4, 6-12, 14-15, 17-18 and 20-23 overcome the rejections of record, and Applicants therefore respectfully solicit allowance of these claims.

The Examiner is invited to contact Applicants' undersigned representative if the Examiner believes such action would expedite resolution of the present Application.

Respectfully submitted,

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